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PRIEST & GOLDSTEIN PLLC 5015 SOUTHPARK DRIVE SUITE 230 DURHAM, NC 27713-7736			BHANDARI, PUNEET	
			ART UNIT	PAPER NUMBER
			2666	

DATE MAILED: 05/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/977,643

Applicant(s)

ROSENBERG, JONATHAN DAVID

Examiner

Puneet Bhandari

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10/16/2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7, 19 and 20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7, 19 and 20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10/16/2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Drawings***

1. The drawings are objected to because In Fig.1 elements 51 and 52 should be S1 and S2 respectively. In Fig. 3 "Time+Lamp" should be changed to "Timestamp" as referred on page 8, line 21.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Double Patenting***

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the

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unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Omum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claim 7 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. US 6,304567.

Although the conflicting claims are not identical, they are not patentably distinct from each other because of following correspondences

Regarding claim 7, a first plurality of telephone sets connected to first termination equipment which terminates said first plurality of telephone sets in first location corresponds to "*a plurality of telephone sets connected to termination equipment which terminates said plurality of telephone sets*" disclosed in claim 1, lines 24-26 of U.S. Patent No. US 6,304567;

The limitation a second plurality of telephone sets connected to second termination equipment which terminates said first plurality of telephone sets in first location corresponds to "*a plurality of telephone sets connected to termination equipment which terminates said plurality of telephone sets*" disclosed in claim 1, lines 24-26 of U.S. Patent No. US 6,304567;

The limitation, respective packet network telephone gateways connected to said first and second termination equipment and to a packet network corresponds to *"respective telephone network gateways are connected to said termination equipment and to a packet network"* disclosed in claim 1, lines 27-28 of U.S. Patent No. US 6,304567;

The limitation, packet gateways are arranged to multiplex voice telephone calls from said first plurality of telephone sets to said second plurality of telephone sets by establishing a transport level connection corresponds to *"whereby said packet network gateways are connected to multiplex voice telephone calls among said plurality of telephone sets to a single transport level connection"* disclosed in claim 1, lines 29-33 of U.S. Patent No. US 6,304567;

The limitation, transport level connection is maintained so long as voice calls are being made between the first and second locations with information from a number of voice telephone calls directed to different ones of second plurality of telephone sets multiplexed into a single packet is disclosed in *"number of voice telephone calls are multiplexed into a single packet"* disclosed in claim 1, lines 30-34 of U.S. Patent No. US 6,304567;

The limitation, packet network is the Internet corresponds to *"wherein said packet network is Internet"* disclosed in claim 1, lines 32-34 of U.S. Patent No. US 6,304567;

The limitation, packet network telephone gateways operate to establish a packet network connection in response to a request from a user associated with one of said telephone sets and said gateways establish a channel for each user within each

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transport level connection corresponds to *"said packet network gateways operate to establish a packet network connection in response to a request from a user associated with one of said telephone sets and said gateways establish a channel for each user within each transport level connection"* disclosed in claim 1, lines 35-39 of U.S. Patent No. US 6,304567;

The limitation, packet network telephone gateways operate to digitize voice signals from said telephone sets, to multiplex blocks of such digitized voice signals onto a transport level connection, and to packetize said multiplexed voice signal corresponds to *"said packet network telephone gateways operate to digitize voice signals from said telephone sets, to multiplex blocks of such digitized voice signals onto a transport level connection, and to packetize said multiplexed voice signal"* disclosed in claim 1, lines 39-43 of U.S. Patent No. US 6,304567;

The limitation, telephone gateways are connected to provide channel identification for each said channel corresponds to *"telephone gateways are connected to provide channel identification for each said channel"* disclosed in claim 1, lines 44-45 of U.S. Patent No. US 6,304567.

Claim 7 differ from claim 1 of U.S. Patent No. US 6,304567 for following reasons. Claim 7 do not claim *"telephone gateways are further connected to send sequence numbers in setup and teardown messages to allow for re-use of channel identifications"*. Therefore claim 7 merely broaden the scope of claim 1 of U.S. Patent No. US 6,304567.

It has been held that the omission of an element and its function is an obvious expedient if the remaining elements perform the same function as before. See In re

Karlosn, 136 USPQ 184 (CCPA). Also not Ex parte Rainu, 168 USPQ 375 (Bd. App. 1969). The omission of reference element whose function is not needed would have been obvious to one skilled in art.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims **1 & 4** are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Baran et al. (US 4,771,425).

Regarding claim **1**, a first plurality of telephone sets connected to first termination equipment (PBX-46), which terminates said first plurality of telephone sets in first location is anticipated by *"telephone sets (60,62) connected to digital PBX (46)"* disclosed in Fig-1;

The limitation, a second plurality of telephone sets connected to second termination equipment which, terminates said first plurality of telephone sets in second location PBX (54) is anticipated by *"telephone sets (68,70) connected to digital PBX (54)"* disclosed in Fig-1.

The limitation, respective packet network telephone gateways connected to said first and second termination equipment and to a packet network is anticipated by *"packet network gateways (18,16) connected to PBX 44, PBX 46 and to a packet network 12"* as disclosed in Fig 1.

The limitation, packet gateway are arranged to multiplex voice telephone calls from said first plurality of telephone sets to said second plurality of telephone sets by establishing a transport level connection is anticipated by *"communication from telephone sets 60& 62 destined for phone sets 68 and 70 are multiplexed into same transport stream carried on trunk 86 (transport level connection)"* disclosed in Fig 1, element 84.

The limitation, transport level connection is maintained so long as voice calls are being made between the first and second locations with information from a number of voice telephone calls directed to different ones of second plurality of telephone sets multiplexed into a single packet is anticipated by *"packet made up of 168 bits of voice or data information, which is about 21 voice channels/calls, where each voice channel carries 8 bits (hence it is clear that Baran's system could multiplex up to 21 voice calls into one packet for transmission over the packet network)"* disclosed in column 6, line 59-column 7, line 3 and Fig. 3A

Regarding claim 4, a private branch comprises said termination equipment is anticipated by "PBX-46 or PBX-54" disclosed in fig-1.

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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7. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Baran et al. (US 4,771,425) in view of Willaims et al. (US 5,883,891). Baran et al. teaches all the limitations of claim 3 (see the rejection for claim 1 above) except Baran et al. fails to disclose central office comprising a the termination equipment. Willaims et al. discloses termination of the telephone set being performed by the central office (refer fig 1A or column 4, lines 50-55 of Willaims et al.). At the time the invention was made it would have been obvious to a person in ordinary skill in art to terminate the telephone sets of Baran et al. by central office instead of a PBX. One in ordinary skill in art would have been motivated to do so with the motivation being to utilize the high termination capacity of central office (since it is a know fact that central office can terminate more lines than a PBX can).

8. Claims 2,5,6 & 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baran et al (US 4,771,425) in view of Gordon (US 5,608786).

Regarding claim 2, Baran et al. teaches all the limitations of claim 3 (see the rejection for claim 1 above) except Baran et al. fails to disclose packet network is an Internet. Gordon teaches that Internet could be used as a packet network for long distance telephony (see Fig. 5 or column 8, lines 62-65). At the time the invention was made it would have been obvious to a person in ordinary skill in art use Internet in a packet network of Baran et al. One in ordinary skill in art would have been motivated to do so with a motivation being to provide long distance telephony communications at a low cost to save money (see column 9, lines 1-4 of Gordon).

Regarding claim 5, Baran et al. also teaches packet network telephone gateways operate to establish a packet network connection in response to a request from a user associated with one of said telephone sets in Fig 1 and gateway establishing a channel for each user within each said transport level connection is disclosed by "establishment of 8 bit for each voice channel" in Fig 1 of Baran et al (US 4,771,425) also see column 6, lines 59-66.

Regarding claim 6, Baran et al. teaches all the limitations of claim 3 (see the rejection for claim 5 above), Baran et al. also teaches "voice signals are digitized at the channel bank (46) and digitized voice signals are multiplexed and packetized at the gateway (Mux-18)" refer fig 1 of Baran et al. Baran et al. fails to teach voice signal are digitized at the gateway. Gordon teaches the gateway (access node 6) accepting and digitizing voice signals (see Fig 1 or column 6, lines 55-59.) This mechanism eliminates channel bank. Thus it would have been obvious to one in ordinary skill in art at the time the invention was made to apply Gordon teaching to Baran et al. system with the motivation being to eliminate the need for separate channel bank to simplify the system and save money.

Regarding claim 19, Fig 1 of Baran et al. teaches a telecommunication system employing a packet network (12) in routing of telecommunication information from an originating point (56,58,60,62) to a destination point (68,70,72,74), comprising a plurality of communication switches (PBX 44, PBX 46, PBX 50) and plurality of gateways for (14,16,18) for interfacing respective ones of the communication switches (PBX 44, PBX 46, PBX 50) with the packet network (12) such that communication information received

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from different originating points (56,58,60,62) and exchanged between one of the gateways (14,16,18) is multiplexed at the same transport level connection is disclosed in Fig 1 and in one data packet is disclosed in column 6, line 59-column 7, line 3 and Fig. 3A *"packet made up of 168 bits of voice or data information, which is about 21 voice channels/calls, where each voice channel carries 8 bits* (hence it is clear that Baran's system could multiplex up to 21 voice calls into one packet for transmission over the packet network)".

Baran et al. fails to disclose packet network is an Internet. Gordon (US 5,608,786) teaches that Internet could be used as a packet network for long distance telephony (see Fig. 5 or column 8, lines 62-65).

At the time the invention was made it would have been obvious to a person in ordinary skill in art use Internet in a packet network of Baran et al (US 4,771,425). One in ordinary skill in art would have been motivated to do so with a motivation being to provide long distance telephony communications at a low cost to save money (see column 9, lines 1-4 of Gordon (US 5,608,786)).

9. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Baran et al. (US 4,771,425) and Gordon (US 5,608,786) as applied to claim 6 above, and further in view of Willaims et al. (US 5,883,891). Baran et al. and Gordon teach all the limitations of claim 7 (see the rejection for claim 6 above) except Baran et al. and Gordon fail to disclose that the telephone gateways are connected to provide channel identification for each channel. Willaims et al. discloses that nodes (gateways) along the route (channel) are designated by a unique IP address (channel identification) (refer

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column 1-line 60-column 2, line 5). At the time the invention was made it would have been obvious to a person in ordinary skill in art to modify the telephone sets of Baran et al. and Gordon by nodes (gateways) connected to provide channel identification for each channel. One in ordinary skill in art would have been motivated to do so to route the packet through Internet (see column 1, lines 60-67 Willaims et al.).

10. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rahman et al. (US 5,274,635) in view of Gordon (US 5,608,786). Fig. 1 of Rahman et al. teaches a telecommunication system employing a packet network in routing of telecommunication information from an originating point (40,42) to a destination point (28), comprising a plurality of communication switches (30) and plurality of gateways (22, 26) is multiplexed at the same transport level connection and in different data packets is disclosed in fig 3 of Rahman et al. *"information from different originating points in different time slots 0,1,2, is multiplexed in different packets 130,131,132 that is sent over the packet network"*.

Rahman et al. fails to disclose packet network is an Internet. Gordon teaches that Internet could be used as a packet network for long distance telephony (see Fig. 5 or column 8, lines 62-65 of Gordon).

At the time the invention was made it would have been obvious to a person in ordinary skill in art use Internet in a packet network of Rahman et al. One in ordinary skill in art would have been motivated to do so with a motivation being to provide long distance telephony communications at a low cost to save money (see column 9, lines 1-4 of Gordon).

**Conclusion**

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure are Weingarten (US 6,078,579), Turock (US 6,243,373), Civanlar et al. (US 6,298,120), Gordon (US 6,067,350) and Maroulis et al. (US 6,584,094).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Puneet Bhandari whose telephone number is 571-272-2057. The examiner can normally be reached on 9.00 AM To 5.30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Seema Rao can be reached on 571-272-3174. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Puneet Bhandari  
Examiner  
Art Unit 2666

*PB*

*Seema S. Rao*  
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